

REMARKS

Claims 1, 3-8, 10-13, and 15-19 are pending in this application. By this amendment, Claims 2, 9, and 14 are cancelled, and Claims 1, 8, 13, and 18 are amended, and Claim 19 is added. No new matter has been added. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

I. THE CLAIMS ARE PATENTABLE OVER U.S. PATENT No. 5,865,791

Claims 1-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,865,791 to Whayne, *et al.* (hereinafter "Whayne"). This rejection is respectfully traversed.

Claims 1, 8, and 13 of the present application are directed to a delivery apparatus for performing a surgical procedure. The delivery apparatus, as recited in the amended claims, comprises; a flexible catheter capable of assuming an angular configuration at a predetermined time during the surgical procedure, wherein the flexible catheter has an outer catheter and an inner catheter movably disposed in the outer catheter; a penetration apparatus disposed within the inner catheter, the penetration apparatus further comprises a first end having a tip for creating an aperture, and a second end that is substantially free; and at least one fastener in communication with the penetration apparatus.

As amended, Claim 18 recites a method for securing a surgical component to a vessel at a surgical site, comprising the steps of: at a surgical site, which comprises the steps of: advancing a delivery apparatus to the surgical site; activating the delivery apparatus to contact the surgical site; advancing the delivery apparatus wherein the

delivery apparatus creates an aperture at the surgical site; and releasing a fastener to the surgical site to secure the surgical component to the vessel, wherein at least one portion of the fastener further comprises a sealant material.

New Claim 19 of the present application is directed to a delivery apparatus for performing a surgical procedure. The delivery apparatus, as recited in the new claim, comprises; a flexible catheter capable of assuming an angular configuration at a predetermined time during the surgical procedure; a penetration apparatus having a solid core disposed within the inner catheter, the penetration apparatus further comprises a first end having a tip for creating an aperture, and a second end that is substantially free; and at least one fastener in communication with the penetration apparatus. Support for the amendments and the new claim may be found at at least paragraphs 0034, 0037, 0039, and 0043 of the present application.

As a preliminary matter, the Office states that the claims of the present application are anticipated by Whayne, but then rejects the claims with a combination of references. Specifically, the Office combines the teachings of Whayne with U.S. Patent No. 5,254,088 to Lundquist *et al* (hereinafter “Lundquist”). Relevant patent law makes clear that rejections based on anticipation must be based on a single prior art reference. The fact that Whayne incorporates Lundquist by reference does not alter this principle. Accordingly, Applicant respectfully requests clarification of the claim rejections.

Nonetheless, taken alone or in combination with another reference, Stevens does not disclose, teach, or suggest the claimed subject matter of the present invention. Stevens is directed to systems and methods for reducing the regions of blood stasis and thrombus formation in atrial appendages in the human body. Stevens discloses a

catheter 112 having a distal tip portion 114 that contains an expandable anchor 116. The distal tip portion *is secured to* the catheter 112. See col. 12, ll. 10-30; Fig. 29 (emphasis added). The expandable anchor in Stevens is adapted to maintain the patient's atrial appendage in a particular position. Stevens does not, however, disclose a delivery apparatus having a flexible catheter which has an outer catheter and an inner catheter movably disposed in the outer catheter; and a penetration apparatus disposed within the inner catheter, as presently claimed. In addition, Stevens does not disclose a delivery apparatus having a flexible catheter; and a penetration apparatus having a solid core disposed within the catheter, as presently claimed. Moreover, Stevens is silent as to securing a surgical component to a vessel and does not disclose or suggest a method as presently claimed.

For at least the reasons set forth above, Applicants respectfully submit that Stevens fails to disclose, teach or suggest the invention claimed by Applicants. Reconsideration and withdrawal of the rejections are respectfully requested.

II. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims of the present invention define subject matter patentable over the references cited by the Office and that the application is in condition for allowance. Should the Office believe that anything further is desirable to place the application in better condition for allowance, the Office is invited to contact Applicants' undersigned attorney at the below listed telephone number.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to deposit account number 03-2469. Moreover, if the deposit account

contains insufficient funds, the Commissioner is hereby invited to contact Applicant's undersigned representative to arrange payment.

Respectfully submitted,

Date: November 15, 2004



JOHN N. COULBY, Reg. No. 43,565
MARK W. RYGIEL, Reg. No. 45,871
COLLIER SHANNON SCOTT, PLLC
3050 K Street, N.W., Suite 400
Washington, D.C. 20007
(202) 342-8400